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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: M. Michael Pitts, Jr. et al.

DOCKET NO.: 111732.00012

SERIAL NO.: 10/796,814

EXAMINER: William T. Leader

FILED: March 9, 2004

ART UNIT: 1742

TITLE: CAPACITIVE ELECTROSTATIC PROCESS FOR INHIBITING THE FORMATION  
OF BIOFILM DEPOSITS IN MEMBRANE-SEPARATION SYSTEMS

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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CERTIFICATE OF MAILING

I hereby certify that on this 17th day of April, 2006, this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By: Alice B Vanicek  
Alice B. Vanicek

TRANSMITTAL OF BRIEF ON APPEAL

Dear Sir:

Pursuant to the provisions of 37 C.F.R. 1.192, the appellant is hereby submitting three (3) copies of a Brief on Appeal in the above-captioned patent application.

Please charge the \$250.00 appeal brief filing fee required by 37 C.F.R. 1.17(c), and any other cost or credit any overpayment associated with the filing of this Brief on Appeal, to our Deposit Account No. 17-0055.

Respectfully submitted,

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Alice B. Vanicek

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TO THE COMMISSIONER FOR PATENTS

BRIEF ON APPEAL

Dear Sir:

This is an appeal from the final rejection dated 11/16/05 from Examiner Leader regarding Application Ser. No. 10/796,814, filed on March 09, 2004.

## **REAL PARTY IN INTEREST**

The real parties in interest are the inventors M. Michael Pitts, Jr. and Rodrigo F.V. Romo.

## **RELATED APPEALS AND INTERFERENCES**

No related appeals or interferences are currently pending.

## **STATUS OF CLAIMS**

Claims 1-3 currently stand rejected and are on appeal.

## **STATUS OF AMENDMENTS**

An amendment dated January 17, 2006, was filed subsequent to final rejection. However, the amendment was not entered. Accordingly, the claims on appeal are the original claims as filed.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

Claim 1 is an independent claim directed to a method for reducing the formation of biofilm deposits on a wall in a water system (for e.g., see Fig. 9) comprising the steps of providing a capacitive electrostatic generator adapted to create an electrostatic field (Figs. 1-3; page 19, lines

15-22); immersing the electrostatic generator in a body of water (Figs. 5 and 6; page 22, lines 4-8) in the water system (Fig. 9), the water system being connected to an electrical ground relative to an electromotive force available for energizing the electrostatic generator (page 22, lines 6-15), and energizing the electrostatic generator with the electromotive force (page 22, lines 20-24), such that a corresponding electrostatic field is created between the generator immersed in the water system and the electrical ground without measurable current leakage in the body of water (page 24, lines 1-11); wherein the capacitive electrostatic generator comprises a vitrified ceramic tube of unibody construction (Figs. 1-3; page 19, lines 20-23) having an integrally-sealed end defining an inner cavity with an inner wall (page 19, lines 22-23); conductive material contained within the inner cavity and disposed in intimate contact with the inner wall (page 20, lines 9-11); electrically-insulated sealing means (page 20, lines 21-25) for providing hermetic closure (page 21, lines 7-10) to the inner cavity; and electrical means (page 22, lines 1-4) for energizing the conductive material with a static electromotive force.

Claim 2 depends from claim 1 and further specifies that the voltage is greater than about 10,000 volts DC (page 33, line 21). Claim 3 depends from claim 1 and further specifies that the voltage is greater than about 30,000 volts DC (page 33, lines 20-24).

#### GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The sole ground of rejection is that of claims 1-3 under 35 U.S.C. 102(b) as being unpatentable over the parent case for this application, U.S. Patent No. 5,591,317 by Pitts.

## ARGUMENT

Re: claims 1-3

The Examiner takes the position the Appellant's own patent (U.S. Patent No. 5,591,317, hereinafter the '317 Patent), to which a priority claim was perfected, anticipates claims 1-3 on appeal. This result clearly cannot stand as it directly contradicts statutory authority on anticipation and priority.

In relevant part, 35 U.S.C. 120 (Benefit of earlier filing date in the United States) reads:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States...which is filed by an inventor or inventors named in the previously filed application **shall have the same effect, as to such invention, as though filed on the date of the prior application....** (emphasis added).

In relevant part, 35 U.S.C. 102(b) (Conditions for patentability) reads:

A person shall be entitled to a patent unless...(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, **more than one year prior to the date of application for patent in the United States....** (emphasis added).

The applicant respectfully submits that the plain language of 35 U.S.C. 120 requires that an application to which a proper priority claim has been made must ("shall") "have the same effect, as to such invention, as though filed on the date of the prior application." The Appellant has perfected (as acknowledged by the Examiner in the Office Action mailed on August 8, 2005, at page 2, paragraph 1) his priority claim to include the '317 Patent. Accordingly, the Appellant must be given the filing date of the parent '317 Patent.

35 U.S.C. 102(b) requires that anticipation be shown by a reference that is "more than one year prior to the date of application for a patent in the United States." Because the claims on appeal have the same filing date as the '317 Patent relied upon by the Examiner in determining anticipation, this rejection is clearly erroneous.

No case law or statutory authority standing for the proposition that an applicant's parent application itself can be used to anticipate a child application was cited by the Examiner. Instead, the Examiner relies solely upon MPEP 2133.01 ("Rejections of Continuation-in-Part (CIP) Application"). The Examiner then goes on to explain that, on the one hand, "the [317 Patent] does not disclose a method for reducing the formation of biofilm deposits on a wall in a water system," yet, on the other hand, "The use of the electrostatic-field generator disclosed and claimed in the '317 Patent is considered to inherently result in reducing the formation of biofilm deposits" (see paragraphs 4 and 5 of the Office Action dated 11/16/2005). In other words, the Examiner states that the '317 Patent inherently discloses the claims under appeal for prior art purposes but not for priority purposes. Aside from being directly contrary to the language 35 U.S.C. 120 for the granted priority claim, the selective application by the Examiner of "inherent disclosure" to find anticipation yet deny priority has no basis in patent law.

It also should be noted that, in response to a previous double patenting rejection involving the parent case discussed above, a proper a fee terminal disclaimer and fee under 37 CFR 1.20(d) was submitted by the Appellant and accepted by the Examiner (Office Action mailed August 8, 2005).

Thus, the Appellant has addressed any possible obviousness issue based on the '317 Patent by disclaiming all term after the parent case expires.

In view of the above, the Appellant respectfully requests that the rejection of claims 1-3 should be reversed in their entirety.

Respectfully submitted,



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## CLAIMS APPENDIX

1. A method for reducing the formation of biofilm deposits on a wall in a water system

comprising the steps of:

providing a capacitive electrostatic generator adapted to create an electrostatic field;

immersing said electrostatic generator in a body of water in the water system, the water system being connected to an electrical ground relative to an electromotive force available for energizing the electrostatic generator; and

energizing said electrostatic generator with said electromotive force, such that a corresponding electrostatic field is created between said generator immersed in the water system and said electrical ground without measurable current leakage in the body of water;

wherein said capacitive electrostatic generator comprises a vitrified ceramic tube of unibody construction having an integrally-sealed end defining an inner cavity with an inner wall; conductive material contained within said inner cavity and disposed in intimate contact with said inner wall; electrically-insulated sealing means for providing hermetic closure to said inner cavity; and electrical means for energizing said conductive material with a static electromotive force.

2. The method of Claim 1, wherein said voltage is greater than about 10,000 volts DC.

3. The method of Claim 1, wherein said voltage is greater than about 30,000 volts DC.

## EVIDENCE APPENDIX

Not applicable.

## **RELATED PROCEEDINGS APPENDIX**

Not applicable.